

REMARKS

The Examiner has rejected Claim 1. No amendments to the claim have been made herein above. Claim 1 is pending in the application.

Rejection under 35 U.S.C. §102:

Claim 1 has been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Ewing U.S. Patent No. 5,236,749. Applicant respectfully traverses this rejection for the following reasons.

The Examiner argues that the Ewing reference anticipates Applicant's claimed invention. In order for a claim to be anticipated under 35 U.S.C. §102, a single prior art reference must disclose each and every element of the claimed invention. Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984). If the reference fails to suggest even one limitation of the claimed invention, the claim is not anticipated. Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

The Examiner has failed to present a single prior art reference that anticipates Applicant's claimed invention. Specifically, despite the Examiner's arguments as to "product-by-process" claim format, the product still cannot be said to be anticipated by the Ewing reference. The Examiner's arguments are that: 1) Ewing discloses an embossed blister formed from a "laminated film" (citing cols. 1 and 2); 2) "process limitations are given little or no patentable weight" in a product-by-process claim format, and "the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind" from the prior art.

First of all, Ewing does not teach or suggest an embossed blister. Ewing does teach a printed blister. The Examiner is referred to Webster's Ninth New Collegiate Dictionary (1991 by Merriam-Webster, Inc., U.S.A.), p. 406, to the definition of the word "emboss". A copy of this excerpt is enclosed for the Examiner's convenience. There, it can be seen that the word is

defined as: to raise the surface of into bosses, to ornament with raised work, or to raise in relief from surface. Hence, "printing" is not "embossing" and vice versa. Turning now to the Ewing reference, column 2, line 2, the reference recites that the film or sheet back may be "printed". There is no teaching or suggestion as to embossing the film.

Secondly, the evidence of the difference between the claimed blister pack and that of the prior art is self-evident within the claimed elements. The differences include those of the product as produced directly by the recited process steps. The Examiner has oversimplified the treatment of product-by-process claim language outside the intent of the case law. The following applies.

In addition to the difference between an embossed blister and a printed one as discussed herein above, the recited process steps in the claim do indeed produce a product distinguishable from the prior art. Referring to claim 1, the blister element is formed "by advancing a pin having a face with an indicia thereon" in engagement with "a platen bearing an indicia forming die thereon and located on the opposite side of said film". In other words, these process elements form an embossed indicia in a film. The process steps clearly breathe meaning, and produce structural elements, into the blister pack product claimed.

Another difference between the claimed product and the Ewing reference is that the claimed "advancing movement of the pin controllably stretches the film around the blister in a manner minimizing stretching of the film located at the base of the blister." This recited process step produces yet another structural feature in the claimed product, i.e., a reduced stretch of the base portion as compared to the film located around the side of the blister. Thus contrary to the Examiner's belief, the process steps produce "readily apparent differences" between the claimed product and that disclosed by Ewing. Applicant has thus met his burden, which shifts to the Examiner and has not been met by the Examiner's application of the Ewing reference.

In summary, not only has the Examiner failed to present a single reference teaching an embossed blister, but has also failed to account for the structural features in the product that are

produced directly as a result of the recited process steps in the claim. Since each and every claim element is not taught by Ewing, claim 1 cannot be said to be anticipated by the reference as a single disclosure. Therefore, a proper rejection in compliance with the requirements of under 35 U.S.C. §102(b) has not been presented by the Examiner.

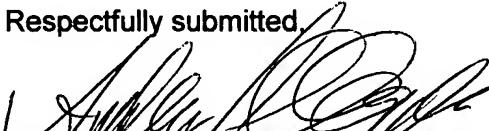
Claim 1 is not anticipated by either reference within the proper meaning of 35 U.S.C. 102. This rejection should, therefore, be withdrawn.

Conclusion:

In light of the above remarks, it is believed that the application is now in condition for allowance, and prompt notification to that effect is earnestly solicited. The Examiner is invited to contact the undersigned to discuss the application on the merits if it is believed that such discussion would expedite the prosecution.

Respectfully submitted,

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